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IN THE

Supreme Court of the United States

OCTOBER TERM 1976

No. 76-1788

ST. REGIS PAPER COMPANY,

Petitioner,

v.

BEMIS COMPANY, INC.,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

RAYMOND J. MCELHANNON,
30 Rockefeller Plaza,
New York, New York 10020.
Telephone: (212) 977-9550
Attorney for Petitioner

Of Counsel:

NORMAN H. ZIVIN,
Cooper, Dunham, Clark, Griffin & Moran,
30 Rockefeller Plaza,
New York, New York 10020.
Telephone: (212) 977-9550

CLYDE H. HAYNES,
St. Regis Paper Company,
150 East 42nd Street,
New York, New York 10017.
Telephone: (212) 697-4400

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Petitioner prays that Writ of Certiorari issue to review the decision of the United States Court of Appeals for the Seventh Circuit, rendered by a divided Court on February 3, 1977 in the above-entitled cause, reversing the District Court's holding of validity of Petitioner's patents in suit.

Citations to the Opinions Below

The opinion of the Seventh Circuit Court of Appeals appears at 549 F.2d 833 and also in the Appendix (A, 1).

The opinion of the District Court, constituting its findings of fact, conclusions of law and judgment, appears at 403 F. Supp. 776 and also in the Appendix (A, 30).

Grounds on Which This Court's Jurisdiction is Invoked

Jurisdiction of this Court is invoked to review the aforesaid decision of the Seventh Circuit Court of Appeals, 549 F. 2d 833 (A, 1), which by a majority opinion and over a strong dissenting opinion, 549 F. 2d at 839 (A, 7), reversed the judgment of the District Court, 403 F. Supp. at 794 (A, 48), which held valid and infringed each of petitioner's U. S. patents in suit, viz., Lokey 3,650,460 (A, 49) and Goodrich Re 28,317 (A, 57) and Re 28,318 (A, 66), pertaining to *articles of manufacture* comprising sift- and leak-proof and insect-impervious multiwall paper bags, 403 F. Supp. at 781 (A, 35). The Court of Appeals majority reversal is based solely on asserted absence of "synergism" of the patented bag structures, 549 F. 2d at 838-9 (A, 5-6), held by the District Court to be "unobvious" under 35 U.S.C. § 103 as assessed pursuant to this Court's "standards" of *Graham* v. *John Deere Co.*, 383 U.S. 1, 17-18, 36 (1966), 403 F. Supp. at 783, 789 (A, 37, 43). Thus the basic issue posited by this petition is whether "synergism" or *"Graham"* or both is or are the law of this Court as to patentability of inventions under 35 U.S.C. § 103 (A, 134), and more particularly as to inventions comprising articles of manufacture.

The date of the Court of Appeals' decision sought to be reviewed is February 3, 1977, 549 F. 2d 833, (A, 1). The date of said Court's order denying petitioner's petition for rehearing (A, 75) is March 17, 1977 (A, 88).

The statutory provision which confers on this Court jurisdiction to review the decision of the Court of Appeals is 28 U.S.C. § 1254(1).

Questions Presented for Review

(a) Is the test for patentability under 35 U.S.C. §103 that enunciated in *Graham* v. *John Deere Co.*, 383 U.S. 1, 17-18, 36 (1966)?

(b) If the test for patentability under 35 U.S.C. §103, is that of *Graham,* did the District Court properly apply this test in holding petitioner's patents in suit to be valid?

(c) If the test for patentability under 35 U.S.C. §103, is that of *Graham,* did the Court of Appeals fail to apply said test in holding all three of petitioner's patents in suit invalid?

(d) Is "synergism", defined as a "combination, resulting in an effect greater than the sum of the several effects taken separately", a necessary requirement for patentability of a combination?

(e) Are the patented bag structures of the patents in suit, which are classifiable as "manufactures" under 35 U.S.C. §101 (A, 134), also properly classifiable as "combinations" requiring "synergism" for patentability, as held by the Court of Appeals?

(f) If synergism is a necessary requirement for patentability of a combination, did the Court of Appeals err in holding that the claimed bag structures of the patents in suit do not involve synergism?

(g) Must a combination structure in order to be patentable, be unobvious under 35 U.S.C. § 103 by the test of *Graham*, and also be "synergistic" as above defined?

(h) Did the Court of Appeals in its denial (A, 88) of plaintiff's petition for rehearing (A, 75) to the Court of Appeals, err in denying plaintiff's request to remand the case to the District Court for further findings as to the presence or absence of synergism as applied to the patented bags of plaintiff's patents in suit (A, 79)?

Statutes Involved

This petition involves Sections 101 and 103 of the Patent Act of 1952, i.e. 35 U.S.C. §§ 101 and 103, which enact that:

> "§ 101. Inventions patentable
>
> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."
>
> "§ 103. Conditions for patentability; non-obvious subject matter
>
> A patent may not be obtained though invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negative by the manner in which the invention was made." (A, 134)

Concise Statement of the Case

Proceedings Below

Petitioner seeks certiorari review by this Court of the Court of Appeals' majority decision holding all three of petitioner's patents in suit invalid under 35 U.S.C. § 103 for alleged lack of "synergism" of the patented structures, citing *Anderson's-Black Rock* v. *Pavement Co.*, 396 U.S. 57, 61 (1969) and *Sakraida* v. *Ag Pro, Inc.*, 425 U.S. 273, 282 (1976) (549 F. 2d at 838, A, 6).

Petitioner submits that the test for patentability under section 103 is that of *Graham* v. *John Deere Co.*, 383 U.S. 1, 17-18, 36 (1966), which contains no "synergism" requirement, and that the District Court correctly applied that test in holding all three patents in suit valid. 403 F. Supp. at 783, 789, 794 (A, 37, 43, 48). Petitioner further submits

that neither the *Anderson's-Black Rock* nor *Sakraida* nor any other decision of this Court holds that "synergism" is a requirement for patentability under 35 U.S.C. 103.

Petitioner also submits that this Court has never previously applied the test of "synergism" to any patented articles of *"manufacture"*, and has only considered this term when evaluating mechanical work producing combinations or machine patents.

Judge Pell of the Court of Appeals, in a dissenting opinion, concurred with the findings of the District Court, stating that. ". . . not only were the district court's findings of fact not clearly erroneous but that the district court reached the correct result for substantially the correct reasons." Indeed, he urged adopting the District Court's opinion as that of the appellate court (549 F. 2d at 839; A, 7).

Of four experienced jurists who have thus far ruled upon the patents in suit, two—Judges Pell and Morgan*—are in irreconcilable conflict with the other two—Judges Swygert and Cummings—as regards validity of the patents. It is to be noted that whereas Judge Pell accepted and endorsed the findings of fact of Judge Morgan (Id. *supra*), the majority opinion of Judges Swygert and Cummings made no reference to the District Court's findings of fact, neither adopting the same nor finding them clearly erroneous.

The Patents In Suit

The majority opinion of the Court of Appeals characterized all three patents in suit as claiming "the invention of specialized bags which prevent leaking and sifting better than previously existing bags" (549 F. 2d at 833-4; A, 1-2). The patented bags are illustrated in Figs. 1-6 inc. of

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* It is noted that Judge Morgan of the District Court has sat on the Seventh Circuit Court of Appeals in patent cases and has written opinions therein. See *LaSalle St. Press, Inc.* v. *McCormick & Henderson, Inc.*, 445 F.2d 84 (CA 7, 1971).

the Court of Appeals' opinion (549 F. 2d at 834-7; A, 2-5 inc.). Figs. 2-4 inc. (A, 3) show three distinctively different end closure terminations covered by the patents in suit. All are characterized by progressive stepping at the open bag ends of the front and rear gusset panels and the rear bag wall with respect to the front bag wall, in a so called "three-step" gusset and rear wall construction. In Fig. 3, at least some of the bag plies are also stepped in the front and rear bag walls, and in Fig. 4, some of the bag plies are additionally stepped in the gusset panels. These bags are increasingly resistant to sifting, leaking and insect penetration in the order of Figs. 2-4. The function of the stepping patterns is to expose portions of the gussets and plies at the bag ends to receive an adhesive. Preferably, a reactivatable, hot melt adhesive, such as a thermoplastic resin adhesive, is pre-applied to the stepped bag ends for sealing the ends closed in permanently sift proof seals.

The Opinions Below

The District Court's Opinion

The District Court's overall appraisal of the inventive contributions of the patents in suit was:

> "The object of the several patents is best defined with relation to the problems sought thereby to be solved. Bag types in use prior to the Lokey concept were susceptible of excessive sifting of dry contents therefrom, the introduction of moisture thereinto, and insect penetration through the sealed portions at either end of the bag. Lokey was designed to achieve a high-strength end-closure construction, having greatly superior sift-proof properties and moisture and insect penetration resistance. The evidence is compatible only with the finding that the invention claimed in Lokey did substantially achieve that object. The structures claimed in RE317 and RE318 do achieve sift, moisture and insect-proof qualities which are substantially enhanced over those bags of the Lokey construction." (403 F. Supp. at 781, A, 35).

The Majority And Dissenting Court Of Appeals Opinions

The majority appeals court opinion nevertheless ignores both the Examiner's and the District Court's findings as to patentability of the petitioner's patents over the prior art cited by the Examiner including the Poppe patent, and the "no more pertinent" patents, such as Windmoller, cited by respondent (403 F. Supp. 783, 789; A, 37, 43). As to Lokey the majority held,

> ". . . [T]he Lokey bag is *only entitled to a patent if the fusion of the old elements* that comprised the Poppe patent and the old element of multiple layering *created a synergistic combination.* We hold that it did not do so". (549 F. 2d at 838-9; A, 6-7).*

And as regards the reissue '317 and '318 patents, the majority held:

> "The concept of stepping the plies of a multilayered bag is revealed in Windmoller and Holscher French patent 1,227,176. See Appendix B. . . . Moreover, the transition from the Lokey bag to the reissue bags would not have required great inventive flair to a person skilled in the art.
>
> "Similarly, the use of hot melt adhesive in the reissue bags, *did not create a synergistic combination.*" (549 F. 2d at 839, A, 7).

Judge Pell, in his dissenting opinion, disagreed with the majority, as follows:

> "I must add it strikes me that an unfortunate result of the majority opinion may well be to chill

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* Emphasis ours except as otherwise noted.

truly inventive combinations which should be as much entitled to patent protection as are the increasingly rare completely 'new under the sun' inventions." (Id., *supra*).

Argument as to Reasons For Granting the Writ

I. Synergism Is Not A Requirement For Patentability

In not one case since *Graham* has this Court specifically held that synergism must be shown to sustain the validity of any patent and particularly of an article-of-manufacture patent. This Court has not ruled on the point since the Patent Act of 1952. The test of patentability remains that of *Graham* and *United States* v. *Adams*, 383 U.S. 39, 48 (1966). The Court of Appeals was not free to depart from the established *Graham* test and to submit a new test of its own formulation, so petitioner submits.

As heretofore pointed out, the majority of the Court of Appeals held all three patents in suit invalid as not comprising combinations which are *"synergistic, that is resulting in an effect greater than the sum of the several effects taken separately"*, citing *Sakraida* v. *Ag Pro, Inc.*, 425 U.S. 273, 282 (1976), and *Anderson's-Black Rock* v. *Pavement Co.*, 396 U.S. 57, 61 (1969) (549 F. 2d at 838; A, 6). Neither of those cases stands for this principle, so petitioner submits.

In *Anderson's-Black Rock*, the issue was validity of a patent for a *combination* of two *mechanical structures*, each operative independently of the other, for laying asphalt pavement. In making that determination, this Court admonished the "strict observance" of the established obviousness and non-obviousness test set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 17 (1966). 396 U.S. at 62. No synergism requirement was established. Indeed, the only reference to "synergism" appeared in the following *dicta* context:

> "A combination of elements *may* result in an effect greater than the sum of the several effects taken separately. *No such synergistic result is argued here.*" 396 U.S. at 61.

In this Court's decision in *Blonder-Tongue* v. *University Foundation*, 402 U.S. 313 (1971), which followed *Anderson's-Black Rock*, the Court reaffirmed the *Graham* "standards",

> ". . . [I]f the issue is non-obviousness, appropriate inquiries would be whether the first validity determination purported to employ the standards announced in *Graham* v. *John Deere Co.* . . ." 402 U.S. at 333.

The later (1976) *Sakraida* case concerned the validity of patent for a water flush system to remove cow manure from the floor of a dairy barn. As in *Anderson's-Black Rock*, *this system comprised a combination of mechanical elements* each operating independently of the others. Again, this Court applied the *Graham* test. 425 U.S. at 279. The term "synergism" entered the picture only because the Fifth Circuit Court of Appeals in that case had found that the system "'does achieve a synergistic result through a novel combination.'" 425 U.S. at 281-2. Thereupon, this Court said:

> "We cannot agree that the combination of these old elements to produce an abrupt release of water directly on the barn floor from storage tanks or pools can properly be characterized as synergistic, that is, 'result[ing] in an effect greater than the sum of the several effects taken separately.' *Anderson's-Black Rock* v. *Pavement Co.*, 396 U.S. 57, 61 (1969)." 425 U.S. at 282.

While "synergism" may be an appropriate term to use in the mechanical, chemical or electrical arts to characterize combinations resulting in an effect greater than the sum of the several effects taken separately, such as the combination of the gases hydrogen and oxygen to produce water, or in combinations of mechanical elements as in *"machines"*, the term "synergism" has *no scientific* meaning when applied to articles of "manufacture" such as the specialized bags of the subject patents.

A "machine" is "an apparatus consisting of interrelated parts with separate functions, which is used in the performance of some kind of work".[1] The patent statutes allow patents for "any new and useful process, *machine, manufacture,* or composition of matter. . . ." 35 U.S.C. § 101 (A, 134). A "manufacture" or "article of manufacture" embraces "whatever is made by the art of industry or man but excludes processes, *machines* and compositions of matter".[2]

It is petitioner's position that the ruling by the Appeals Court applying principles of "synergism" derived from patented "machine" cases (wherein the interrelated parts perform work) as in *Anderson's-Black Rock* and *Sakraida,* to "articles of manufacture" inventions, abrogates the statute, 35 U.S.C. 101, relating to manufactured items or articles of manufacture without considering the effects thereon to the point where the decision "might well chill the disclosure of invention."[3] It is suggested that an "article of manufacture" cannot interrelate elemental components or

1. *Deller's Walker on Patents,* 2d Ed., § 16, p. 119.

2. *Deller's Walker on Patents,* 2d Ed., § 17, p. 123.

3. *Walker Process* v. *Food Machine & Chem. Corp.,* 382 U.S. 172, 180; 86 S.Ct. 347, 353 (1965), Mr. Justice Harlan concurring. It is noted that Circuit Judge Pell in his dissent stated that the "result of the majority opinion may well be to chill truly inventive combinations. . . ." (549 F. 2d at 839).

effects *in the same sense* that the parts of a "machine" can interrelate them.

Petitioner respectfully submits that the radical step taken by the Appeals Court of applying principles of synergism derived from moving interrelated part machine cases to articles of manufacture and the potential consequences of such an application, fully justify corrective action by this Court. The *Sakraida* and *Anderson's-Black Rock* cases relied on by the Appeals Court, involved patented *machines* that performed work. Petitioner submits that these cases have no pertinency to petitioner's article-of-manufacture patents here involved.

II. The Majority's Opinion Creates New Law For Invalidating Petitioner's Patents

The majority's opinion holds with reference to patentability under Section 103 of combinations of allegedly old elements that,

> "Unless the combination is synergistic, that is result-[ing] in an effect greater than the sum of the several effects taken separately, it cannot be patented.",

citing *Anderson's-Black Rock* and *Sakraida.*

But neither of these decisions nor any others of this Court so holds as applied to Section 103. In addition this Court's dicta as to synergism in the above decisions were made with reference to work producing mechanical combinations or machines, and not with reference to manufactures, to which synergism has no meaning so petitioner submits.

Furthermore the statute, Section 103, makes no reference to absence of synergism as a test for unpatentability but only as to obviousness to a person of ordinary skill in the art. And the same likewise applies to the *Graham*

"standards" for assessing patentability or unpatentability under Section 103.

According to *Graham* the scope and content of the prior art are to be determined, differences between the prior art and the claims in issue are to be ascertained, and the level of ordinary skill in the art resolved, and obviousness or non-obviousness of the subject matter thus determined. 383 U.S. at 17-18. These standards are devoid of any reference to synergism as a test for patentability.

The majority Appeals Court decision in holding petitioner's patents invalid ignores these tests for patentability on which the District Court's findings are based, and substitutes therefor a new test for patentability, namely, synergism, the alleged absence of which the majority holds is the work product only of the "skillful mechanic not that of the inventor". The majority opinion, therefore, makes no pretense of assessing the level of ordinary skill in the art according to the *Graham* standards with reference to Section 103, but substitutes therefor the test of synergism the absence of which is equated with the level of ordinary skill in the art. Such test is completely foreign to any decisions of this Court in construing patentability under Section 103.

Petitioner, therefore, submits that the majority Appeals Court opinion creates new law contrary to the decisions of this Court and of such far reaching scope as applied both to the lower courts and the practicing legal profession, as to exhort a ruling by this Court that synergism is not a test for patentability of a combination, and more particularly of a manufacture under Section 101, such as the bags of petitioner's patents.

III. The Majority's Refusal To Accept The District Court's Findings Of Fact Was Reversible Error

The majority Appeals Court opinion makes no reference to the District Court's findings of fact neither accepting the same or showing them to be clearly erroneous, and thereby

committed reversible error so petitioner submits. As this Court held in *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 336 U.S. 271 (1949),

> "Rule 52(a) of the Federal Rules of Civil Procedure, 28 U.S.C.A., provides in part; 'Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses.' To no type of case is this last clause more appropriately applicable than to the one before us, where the evidence is largely the *testimony of experts** as to which a trial court may be enlightened by scientific demonstrations.
>
> * * *
>
> "While the ultimate question of the patentability is one of meeting the requirements of the statute, R.S. § 4886, as amended, 35 U.S.C.A. § 31, the *facts* as found with respect to these four flux claims warrant a conclusion here that as a matter of law those statutory requirements have been met." (emphasis added) (Id. at 274-275)

The District Court found as facts on the evidence in this case that prior to Lokey's invention "the industry had devised no workable means to securely seal the bag ends to avoid sifting", that "Lokey provided the answer to that long felt need, and that his concept met with substantial commercial success" 403 F. Supp. at 783 (A, 37). That Court also found as to the reissue patents that the "structures claimed in RE317 and RE318 do achieve sift, moisture and insect-proof qualities which are substantially enhanced over those of the Lokey construction" 403 F. Supp. 781 (A, 35).

The District Court further found as facts that petitioner's patents were allowed by the Patent Office over the

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* The evidence in the instant case was principally that of *technical experts* (A, 89, 115, 126).

most pertinent prior art cited by respondent and that "defendants own technical experts admitted in their testimony that such prior art patents were inoperative to achieve a sift proof seal." 403 F. Supp. 783 (A, 37). As to this, based on the admissions against interest of respondent's *technical experts,* Becker and Connolly, (A, 115-119 and 126-133), given with reference to the prior art Poppe and Schenck patents (A, 111 and 120). As to the Windmoller French patent 1,227,176 (A, 11-20), the bag thereof contains a completely heat sealed inner *plastic sack* to reduce sifting, a notoriously old expedient, which is wholly irrelevant to elimination of sifting in multiwall *paper* bags, as the District Court found (Id., *supra*).

Also nowhere does the majority opinion address itself to the *sifting problem* solved by petitioner's patents, but to the wholly unrelated matter of multiwalling paper bags for *strength,* also a notoriously old-in-the-art concept with respect to which petitioner's patents are in nowise concerned. 549 F. 2d at 828-829 ¶[2] (A, 6-7).

The majority Appeals Court opinion ignoring all of these findings, held as a matter of erroneous law that all of petitioner's patents were invalid for lack of synergism, 549 F. 2d 833, 839 (A, 6-7).

IV. Although Synergism Is Not A Requirement For Patentability, The Patented Bags Are Synergistic And Non-Obvious

Petitioner submits that the majority opinion of the Court of Appeals overlooked the important fact, that before the inventions of the patents in suit all prior known multi-wall bags leaked, sifted and were subject to insect infestation, as testified to by Petitioner's witness, Searle, without dispute (A, 90-102). The patented inventions for the first time eliminated these defects by providing bags "having greatly superior sift-proof properties and moisture and insect penetration resistance," as the District Court found, 403 F. Supp. at 781 (A, 35). *Petitioner submits that nothing could be more strikingly synergistic than this.* Here, the patented structures result in "an effect greater than the sum of the several effects taken separately", because the several effects produced only leaky and sifty bags, whereas the patented inventions eliminated these defects and achieved "substantial commercial success," as the District Court held. 403 F. Supp. 781, 783 (A, 35, 37).

V. If Synergism Is Deemed Controlling As To Patentability, Remand Should Be Ordered For Further Evidence Thereon In The Interests Of Justice

Synergism as a requirement for patentability of petitioner's patents was first injected into this case *sua sponte* by the majority Appeals Court decision of February 3, 1977, prior to which it had never been raised by respondent under 35 U.S.C. § 282 (A, 134) or otherwise, either during trial or thereafter. Petitioner, therefore, submits that in the interests of justice, the Appellate Court should have granted the request (A, 79), in petitioner's rehearing petition (A, 75) that the cause be remanded to the District Court for findings on that issue, instead of denying said petition *in toto* (A, 88).

At the time this case was tried in 1974 (A, 89) and decided by the District Court in 1975 (A, 30), *Graham* was the controlling law of this Court on the issue of patentability under section 103 as affirmed by this Court's 1971 decision in *Blonder-Tongue* (402 U.S. at 313), which makes no mention of "synergism". This Court's 1976 decision in *Sakraida* was subsequent to the District Court's decision herein. Neither *Anderson's-Black Rock* nor *Sakraida* holds synergism to be a requirement for patentability in general

and more specifically as applied to articles of *manufacture*, such as petitioner's patented *bags*.

The upshot of the above is that the majority Appeals Court decision has held petitioner's patents invalid on a ground, alleged absence of synergism, on which petitioner has never been heard in rebuttal, because never raised by respondent and because of the Court of Appeals' denial of petitioner's petition for a remand. These factors call for corrective action by this Court so petitioner submits. Authority therefor is found in this Court's decision in *Blonder-Tongue*, wherein it ordered a remand to supplement the record under conditions analogous to these here involved, 402 U.S. at 333, 350.

Conclusion

Not one statute or decision of this Court has held synergism to be a requirement for patentability. The Court of Appeals held synergism to be such a requirement, and took it upon itself to find lack of synergism as to the patents in suit, an issue which had never been presented to the District Court, and thereupon overruled the District Court without finding any error by the District Court. Petitioner submits that such action should be reviewed by this Court so that other courts, practicing lawyers as well as the general public can be guided accordingly as to the law of the land.

It is submitted that for reasons above enumerated the petition should be granted.

Respectfully submitted,

By .....

RAYMOND J. MCELHANNON,
Attorney for Petitioner
30 Rockefeller Plaza,
New York, New York 10020.
Telephone: (212) 977-9550

Of Counsel:
NORMAN H. ZIVIN,
Cooper, Dunham, Clark, Griffin & Moran,
30 Rockefeller Plaza,
New York, New York 10020.
Telephone: (212) 977-9550

CLYDE H. HAYNES,
St. Regis Paper Company,
150 East 42nd Street,
New York, New York 10017.
Telephone: (212) 697-4400